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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,261	04/26/2006	Marcus Guzmann	289256US0PCT	9640
22850	7590	03/27/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER MRUK, BRIAN P	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			03/27/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/577,261	<b>Applicant(s)</b> GUZMANN ET AL.	
	<b>Examiner</b> Brian P. Mruk	<b>Art Unit</b> 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/24/06</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. Claim 1 provides for the use of copolymers, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

4. Claims 2-7 are rejected under 35 U.S.C. 112, second paragraph, for being dependent from claim 1. Appropriate correction and/or clarification is required.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoneda et al, US 2003/0158361.

Yoneda et al, US 2003/0158361, discloses a copolymer for use as a detergent (see abstract and paragraph [0002]) made by copolymerizing a (meth)acrylic acid type monomer A and an unsaturated polyalkylene glycol type monomer B (see abstract and paragraph [0152]). It is further taught by Yoneda et al that the copolymer contains 30-99 mass% of the (meth)acrylic acid type monomer A and 1-70 mass% of the unsaturated polyalkylene glycol type monomer B (see paragraph [0168]), that the copolymer also contains a sulfonic group (see paragraph [0169]), and that the copolymer is used as a dispersant in household detergents (see paragraph [0151]), per the requirements of the instant invention. Specifically, note Example 45, which contains a copolymer containing 2.5 moles of acrylic acid, 0.7 moles of methacrylic acid, and 0.11 moles of IPN-10 (i.e. 10 moles of ethylene oxide added to 80% 3-methyl-3-buten-1-ol, see paragraph [0369]), as required in the instant claims. Also note the copolymers disclosed in Tables 18 and 20. Furthermore, the examiner asserts that "The fact remains that one of ordinary skill informed by the teachings of Yoneda et al would not have had to choose judiciously from a genus of possible combinations to obtain the very subject matter to which appellant's composition per se claims are directed." *In re Sivaramakrishnan*, 213 USPQ 441 (CCPA 1982). Therefore, instant claims 1-7 are anticipated by Yoneda et al, US 2003/0158361.

In the alternative that the above disclosure is insufficient to anticipate the above listed claims, it would have nonetheless been obvious to the skilled artisan to produce the claimed composition, as the reference teaches each of the claimed ingredients

within the claimed proportions for the same utility. Furthermore, the examiner asserts that “Mere fact that a reference suggests multitude of possible combinations does not in and of itself make any one of those combinations less obvious.” *Merck v. Biocraft*, 10 USPQ2d 1843 (Fed. Cir. 1989).

8. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukuda, JP 03185184.

Fukuda, JP 03185184, discloses a copolymer used in detergents comprising a monomer of formula A and at least one monomer B selected from the group consisting of maleic acid, acrylic acid and methacrylic acid (see abstract and page 2, lines 1-18). It is further taught by Fukuda that the ratio of monomer A to monomer B is .05-1, preferably 0.1-0.5 (see page 6, line 4-8), and that monomer B includes mixtures of acrylic acid and methacrylic acid (see page 5, line 29-page 6, line 3), per the requirements of the instant invention. Although Fukuda generally discloses a copolymer containing mixtures of acrylic acid and methacrylic acid as monomer B, the reference does not teach such copolymers with sufficient specificity to constitute anticipation.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have formulated a copolymer, as taught by Fukuda, which contained a monomer B that was a mixture of acrylic acid and methacrylic acid, because such copolymers fall within the scope of those taught by Fukuda. Therefore, one of ordinary skill in the art would have had a reasonable expectation of success, because such a copolymer containing a mixture of acrylic acid and methacrylic acid as monomer B is expressly suggested by the Fukuda disclosure and therefore is an obvious formulation.

9. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsuhiro, JP 2000024691.

Katsuhiro, JP 2000024691, discloses a copolymer used in detergents comprising monomer A, which is a carboxylate moiety, and monomer B, which is a polyalkylene oxide group (see abstract). It is further taught by Katsuhiro that the ratio by weight of monomer A to monomer B is 40-98 to 2-60 (see page 2, claim 3), that monomer A includes mixtures of acrylic acid and methacrylic acid (see page 7, paragraph [0009]), and that monomer B includes (alkoxy) polyethylene glycol mono(meth)acrylate (see page 8, paragraph [0011]), per the requirements of the instant invention. Although Katsuhiro generally discloses a copolymer containing mixtures of acrylic acid and methacrylic acid as monomer A, the reference does not teach such copolymers with sufficient specificity to constitute anticipation.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to have formulated a copolymer, as taught by Katsuhiro, which contained a monomer A that was a mixture of acrylic acid and methacrylic acid, because such copolymers fall within the scope of those taught by Katsuhiro. Therefore, one of ordinary skill in the art would have had a reasonable expectation of success, because such a copolymer containing a mixture of acrylic acid and methacrylic acid as monomer A is expressly suggested by the Katsuhiro disclosure and therefore is an obvious formulation.

### ***Double Patenting***

10. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

11. Claim 7 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 20 of copending Application No. 10/516,201. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).



13. Claims 1-7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 and 10-11 of copending Application No. 10/515,638. Although the conflicting claims are not identical, they are not patentably distinct from each other because copending Application No. 10/515,638 claims a similar method and composition for inhibiting the formation of deposits during machine dishwasher comprising a copolymer containing 30-95 mol% of a carboxylic acid monomer, including mixtures of acrylic acid and methacrylic acid, 3-35 mol% of a monomer of formula I, and 2-35 mol% of a monomer of formula II, wherein the copolymer contains  $\text{--SO}_3^-\text{Na}^+$  and/or  $\text{--SO}_4^-\text{Na}^+$  as end-groups (see claims 1-7 and 10-11 of copending Application No. 10/515,638), as required in the instant claims. Therefore, instant claims 1-7 are an obvious formulation in view of claims 1-7 and 10-11 of copending Application No. 10/515,638.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Mruk whose telephone number is (571) 272-1321. The examiner can normally be reached on Mon-Thurs (7:00 AM-5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian P Mruk/  
Primary Examiner, Art Unit 1796

Brian P Mruk  
March 5, 2008

Brian P Mruk  
Primary Examiner  
Art Unit 1796